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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,838	09/30/2003	Krista Bendig	60001.0371US01 MS300513.1	6904
7590 11/29/2006 Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0903			EXAMINER HILLERY, NATHAN	
			ART UNIT 2176	PAPER NUMBER

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/675,838	Applicant(s) BENDIG, KRISTA	
	Examiner Nathan Hillery	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 9/11/06.
2. Claims 1 – 28 are pending in the case. Claims 1, 14 and 20 are independent.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 14 – 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 14 – 19 have no practical application of a judicial exception as claimed because there is neither a physical transformation nor a production of a concrete, useful and tangible result.

- a. The claimed invention remains in the abstract and nothing is made available to the user; thus it does not produce a tangible result. Particularly, traversing a document does not produce a real world result as argued by Applicant (p 7, third paragraph). Furthermore, the claims do not recite a presentation of any type, in contradistinction to Applicant's arguments (p 7, third paragraph).

- b. The claims appear to be in the preliminary stages and fall short of the disclosed practical utility. In other words, the claims fail to fulfill and/or reflect the specific, substantial, and credible utility sought by the disclosed invention, and thus do not produce a useful result.

5. Consequently, claims 14 – 19 are nonstatutory. The claims simply recite locating, determining, and traversing data without producing a concrete, useful, and tangible result.

6. Further, to expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 above are further rejected as set forth below in anticipation of applicant amending these claims to make them statutory.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 14 – 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Office can not find any support for the limitation “traversing the electronic document based on the tagged data items” recited in line 10 of claim 14.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, 6 – 22, and 25 – 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maynard (US 6175830 B1) and further in view of Douglas et al. (US 20020040311 A1).

11. **Regarding independent claim 1**, Maynard teaches that *The search module will utilize the search query to search through the database records 24a-24z so as to find the database records 30 matching the words or phrases in the search query* (Column 6, lines 58 – 61), which meet the limitation of **locating one or more of the search results generated by the search of the electronic document**.

Maynard further teaches that *In some instances, the finite element can be the entire document itself. The break module is also responsible for analyzing the contents of each finite element 20a-20z and creating a categorical tag 22a-22z for each finite element, which is to be inserted into the finite element* (Column 6, lines 13 – 18) and Maynard also teaches that *The index module parses through each of the finite elements created by the break module and creates a searchable database 23 including a database record 24a-24z for each of the finite elements created by the break module* (Column 6, lines 30 – 33), which meet the limitation of **identifying each of the tagged data items present in the electronic document within a distance from each search result**.

Maynard teaches that *Specifically, the hierarchy selection will inform the search module whether or not the search results are to be displayed in an order or structure*

*based entirely upon the information contained within the categorical tags (research-centric) (Column 6, lines 48 – 52), which meet the limitation of **displaying the one or more tagged items identified as within the distance from each search result.***

Maynard does not explicitly teach **identifying each of the tagged data items present in the electronic document within a distance from each search result using a proximity rule.**

Douglas et al. teach that a computer processor applies calculation logic stored in the method 10 to automatically calculate statistics and/or relevancy ratings 24 based on keywords 14 found in the document 12 using algorithms for frequency, location, density, proximity (paragraph block 0020), which meet the limitation of **identifying each of the tagged data items present in the electronic document within a distance from each search result using a proximity rule.**

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Maynard with that of Douglas et al. because such a combination would provide the users of Maynard with using detected keywords to rate each web document visited (paragraph block 0011).

12. **Regarding independent claim 14**, Maynard teaches that *The search module will utilize the search query to search through the database records 24a-24z so as to find the database records 30 matching the words or phrases in the search query* (Column 6, lines 58 – 61), which meet the limitation of **completing the search of the**

electronic document and locating each result of the search within the electronic document.

Maynard further teaches that *In some instances, the finite element can be the entire document itself. The break module is also responsible for analyzing the contents of each finite element 20a-20z and creating a categorical tag 22a-22z for each finite element, which is to be inserted into the finite element* (Column 6, lines 13 – 18) and Maynard also teaches that *The index module parses through each of the finite elements created by the break module and creates a searchable database 23 including a database record 24a-24z for each of the finite elements created by the break module* (Column 6, lines 30 – 33), which meet the limitation of **determining if one or more of the tagged data items are present in the electronic document within a distance from each search result, wherein the distance comprises a location of the one or more tagged data items relative to each search result.**

Maynard teaches that on the search results screen the end user will select which chapter he or she would like to view a relevant finite element from and the display will then expand to show the finite elements from that chapter matching the search query. These finite elements contained within this chapter will be ordered depending upon the weight of the search query or words (Column 7, lines 7 – 13), which meet the limitation of **traversing the electronic document based on the tagged data items**, in so far as could be understood in light of the rejection under 35 USC 112, first paragraph.

Maynard does not explicitly teach **determining if one or more of the tagged data items are present in the electronic document within a distance from each**

search result using a proximity rule, wherein the distance comprises a location of the one or more tagged data items relative to each search result.

Douglas et al. teach that a computer processor applies calculation logic stored in the method 10 to automatically calculate statistics and/or relevancy ratings 24 based on keywords 14 found in the document 12 using algorithms for frequency, location, density, proximity (paragraph block 0020), which meet the limitation of **determining if one or more of the tagged data items are present in the electronic document within a distance from each search result using a proximity rule, wherein the distance comprises a location of the one or more tagged data items relative to each search result.**

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Maynard with that of Douglas et al. because such a combination would provide the users of Maynard with using detected keywords to rate each web document visited (paragraph block 0011).

13. **Regarding dependent claims 2, and 10 – 13,** Maynard teaches that *The break module 10 parses through an informational resource, such as a group of documents 18 to break up the group of documents into "finite elements" 20a-20z. Each finite element is a user-defined "basket" of information from documents that is to be individually indexed and searched. The finite element is usually not a single word, phrase or symbol, but is a section or portion of an informational resource that can be identified and isolated by the break module. A simple example of a finite element would be the*

individual paragraphs of a document. Other examples of finite elements would include sub-chapters of a document, individual pages of a document, and other types of identifiable sections of a document. In some instances, the finite element can be the entire document itself (Column 6, lines 1 – 14), which meet the limitation of the
distance from each search result comprises the distance between a first paragraph mark and a second paragraph mark, wherein one or more of the search results are located between the first paragraph mark and the second paragraph mark within the electronic document; calculating the distance between each search result and each tagged data item; and determining if the calculated distance is less than a distance criterion; the distance criterion is a number of lines of text; the distance criterion is a number of alphanumeric characters; the distance from each search result comprises a distance based on grammatical rules of a language comprising the electronic document.

14. **Regarding dependent claim 7,** Maynard teaches that *From there, the user will make a selection 34 indicating to the un-break module 16 which of the finite elements the user wishes to view (Column 7, lines 14 – 16) as illustrated in Fig 1.34, which meet the limitation of*
each tagged data item is displayed as a hyperlink and each hyperlink corresponds to a location in the electronic document containing of the tagged data item.

15. **Regarding dependent claims 8 and 9**, Maynard teaches that *The categorical tag may also include an organizational attribute such as pertaining to the type of finite element or the location of the finite element within the document, a date stamp, a categorical word or phrase summarizing the contents of the finite element, etc.* (Column 6, lines 21 – 25), which meet the limitation of **the one or more tagged data items belong to one or more categories of data; the categories of data comprise people's names, physical addresses, e-mail addresses, universal resource locators, dates, and telephone numbers.**

16. **Regarding dependent claim 6**, Maynard teaches that A second level of the display results may order the finite elements for each chapter based upon the weight or frequency that the search words or phrases appear within each finite element (Column 7, lines 4 – 7), which meet the limitation of **the step of determining the tagged data items present in the electronic document within a distance from each search result that comprise a subset of the tagged data items based on a search term prior to displaying the tagged data items.**

17. **Regarding claims 14 – 19**, the claims incorporate substantially similar subject matter as claims 1, 2, 6 – 13 and are rejected along the same rationale.

18. **Regarding claims 20, 21, 22, 25 – 28**, the claims incorporate substantially similar subject matter as claims 1, 2, 6 – 13 and are rejected along the same rationale.

19. Claims 3 – 5, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maynard (US 6175830 B1) as applied to claims 1, 14, and 20 above, and further in view of Kadayam et al. (US 20030212673 A1).

20. **Regarding dependent claims 3 and 4**, Kadayam et al. illustrate in Figure 3 an example screen-shot of the exemplary embodiment, which meet the limitation of **the one or more tagged items identified as within the distance from each search result are displayed by a user interface in a window separate from a window displaying content of the electronic document; any of the tagged items identified as within the distance from each search result are displayed at the top of the separate window and the one or more search results are displayed beneath the displayed tagged data items** (Fig 3. 44). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Maynard with that of Kadayam et al. because such a combination would provide the users of Maynard with *an enterprise-scale system and method for searching and retrieving electronic information from disparate electronic information sources within a large organization (an intranet) and/or from the Internet* (p 1, paragraph block 0006).

21. **Regarding dependent claim 5**, Kadayam et al. illustrate in Figure 16 an example screen shot of the exemplary embodiment, which meet the limitation of **each tagged item identified as within the distance from one or more search result is**

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displayed adjacent to the search result in the separate window. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Maynard with that of Sumita et al. because such a combination would provide the users of Maynard with *an enterprise-scale system and method for searching and retrieving electronic information from disparate electronic information sources within a large organization (an intranet) and/or from the Internet* (p 1, paragraph block 0006).

22. **Regarding claims 23 and 24**, the claims incorporate substantially similar subject matter as claims 3 – 5 and are rejected along the same rationale.

Response to Arguments

23. Applicant's arguments with respect to claims 1 – 28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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